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10/692,321

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Simon Monk

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LADAS & PARRY

5670 WILSHIRE BOULEVARD, SUITE 2100

LOS ANGELES, CA 90036-5679

EXAMINER

RANGREJ, SHEETAL

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/692,321	Applicant(s) MONK, SIMON	
	Examiner SHEETAL R. RANGREJ	Art Unit 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

1. Claims 1-24 are cancelled.
2. Claims 25-37 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 25-37 are rejected as being directed toward non-statutory subject matter because they are software per se. Claims 26 recite “**routine**” and “**module**” as well as a several elements that appear to be software modules or computer programs. The current claim language does not specify the software is part of or statically embodied and executable in a physical medium. Software not statically embodied on a physical medium and executable is considered descriptive material per se. As drafted, the claim fails to define any structural and functional interrelationships between the software per se and other elements of the invention that permit the software's function to be realized. (See MPEP § 2106 Section IV B 1 (a)).

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, *Schrader*, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive

material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 26 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26 and 37 recites limitations in “means plus function” language. The scope of a “means” limitation is defined as the corresponding structure or material set forth in the written description and equivalents thereof. See MPEP § 2181 through § 2186. If there is no disclosure

of structure, material or acts for performing the recited function in the specification, the claim limitation lacks specificity, and fails to satisfy the requirements of 35 U.S.C. 112, second paragraph.

Recent court cases have held that simply reciting “software” without providing some detail about the means to accomplish the function is not enough. *See Aristocrat Techs. Austl. Pty v. Int'l Game Tech.*, ___ F.3d ___, 2008 U.S. App. LEXIS 6472, at *10 [86 USPQ2d 1235] (Fed. Cir. Mar. 28, 2008) (“For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph 6.”). The Court in *Aristocrat* did not require a listing of source code or a highly detailed description of the algorithm to be used to achieve the claimed functions in order to satisfy 35 U.S.C. §112 paragraph 6. It did require, however, the disclosure of at least the algorithm that transformed the general purpose microprocessor to a “special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming*, 184 F.3d at 1349. Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm or description of structure corresponding to the claimed function to provide the necessary structure under 35 U.S.C. §112 paragraph 6.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 25-27 and 37 are rejected under 35 U.S.C. 102(e) as being taught by White et al. (U.S. Publication No. 2002/0091550).

9. As per claim 25, White teaches a computer system for providing a travel insurance product comprising:

-a server system, the server system including,

-a verification routine arranged to receive an identification request from a subscriber to verify the subscriber (**White: figure 2; para. 95**),

-a receiving means arranged to receive a subscriber request for the travel insurance product (**White: figure 2; para. 95**),

-a pricing module arranged to compute a price for the travel insurance product requested by the subscriber utilizing a plurality of stored data (**White: para. 122; 131-132**),

-a payment module arranged to communicate the price to the subscriber and receive payment details from the subscriber to execute payment via electronic transfer, and whereupon payment

has been executed (**White: para. 95; 126-127**),

-an issuing component arranged to issue the insurance product to the subscriber and update the stored data (**White: para. 95**), characterized in that the issuing component of the server system, in response to a further subscriber request, allows the subscriber to vary at least one term of the issued travel insurance product (**White: para. 122-123; 140; para. 153**).

10. As per claim 26, the system of claim 25 is as described. White further teaches further comprising: a client system having an interface that prompts information from the subscriber wherein the information sent to the server system includes at least one of verifying the subscriber, requesting an insurance product and submitting details for payment (**White: figure 4; para. 95; 122-123; 126-127; 131-132; 140; para. 153**).

11. As per claim 27, the system of claim 26 is as described. White further teaches wherein the system further includes a telecommunication means arranged to transmit the information between the client system and the server system (**White: para. 97-103**).

12. As per claim 37, it is a method claim which repeats the same limitations of claim 25, the corresponding system claim, as a series of process steps as opposed to a collection of elements. Since the teaching of White discloses the structural elements that constitute the system of claim 25, it is respectfully submitted that they perform the underlying process steps, as well. As such, the limitations of claim 37 are rejected for the same reasons given above for claim 25.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265).

15. As per claim 28, the system of claims 26 or 27 is as described. White does not teach further comprising a database that includes at least one table of data, wherein the information obtained from the subscriber is utilised to locate a value in the at least one table of data, the value being the purchase cost of the insurance product.

Kleinberg teaches further comprising a database that includes at least one table of data, wherein the information obtained from the subscriber is utilised to locate a value in the at least one table of data, the value being the purchase cost of the insurance product (**Kleinberg: para. 0039-0040; figure 3**).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of White and Kleinberg with the motivation that insurance policies respond to different customer description data and therefore help customers by providing a preferential ranking of quotes that could be used for insurance (**Kleinberg: para. 0020**).

16. As per claim 29, the system of claim 28 is as described. White does not teach wherein the database includes a first and a second table, the first table being utilized to calculate the cost to the subscriber when the subscriber is issued with the insurance product, and the second table being utilized to calculate the cost to the subscriber when the subscriber varies the at least one term in the insurance product.

Kleinberg teaches wherein the database includes a first and a second table, the first table being utilized to calculate the cost to the subscriber when the subscriber is issued with the insurance product, and the second table being utilized to calculate the cost to the subscriber when the subscriber varies the at least one term in the insurance product (**Kleinberg: para. 0039-0040; figure 3**).

The motivation to combine the teachings is the same as claim 28.

17. As per claim 30, the system of claim 29 is as described. White further teaches comprising authenticating means to authenticate the subscriber before obtaining information from the subscriber (**White: figure 2; para. 95**).

18. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265) and further in view of Provost et al. (U.S. Patent No. 6,341,265).

19. As per claim 31, the system of claim 30 is as described. White and Kleinberg do not explicitly teach wherein the client system further includes a claims interface to prompt a subscriber to provide claim information, the claim information being compared with a predetermined rule set contained within the database, to determine whether the subscriber is entitled to receive compensation for the claim.

Provost teaches wherein the client system further includes a claims interface to prompt a subscriber to provide claim information, the claim information being compared with a predetermined rule set contained within the database, to determine whether the subscriber is entitled to receive compensation for the claim (**Provost: figure 3 & 4B**).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of White, Kleinberg, and Provost with the motivation that careful review of payment requests minimizes fraud and unintentional errors and provides consistency of payment (**Provost: col. 1, 31-38**).

20. As per claim 32, the system of claim 31 is as described. White and Kleinberg do not explicitly teach wherein the server system includes an interface which communicates the claim information to an insurance underwriter for further processing.

Provost teaches wherein the server system includes an interface which communicates the claim information to an insurance underwriter for further processing(**Provost: col. 1, 64 to col. 3, 13**).

The motivation to combine the teachings is the same as claim 31.

21. As per claim 33, the system of claim 32 is as described. White does not teach wherein the at least one term of the insurance product is the time period for which the insurance product is valid.

Kleinberg teaches wherein the at least one term of the insurance product is the time period for which the insurance product is valid (**Kleinberg: para. 0038**). The examiner interprets that the length of trip is the same as time period for which the insurance product is valid.

The motivation to combine the teachings is the same as claim 1 and 31.

22. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (U.S. Publication No. 2002/0091550) in view of Kleinberg (U.S. Publication No. 2001/0037265) and further in view of Provost et al. (U.S. Patent No. 6,341,265) and Mori et al. (U.S. Patent No. 6,070,148).

23. As per claim 34, the system of claim 32 is as described. White, Kleinberg, and Provost do not explicitly teach wherein the at least one term of the insurance product is the intended destination of the subscriber.

Mori teaches wherein the at least one term of the insurance product is the intended destination of the subscriber (**Mori: figure 14**).

One of ordinary skill in the art at the time the invention was made would have found it obvious to combine the teachings of White, Kleinberg, Provost, and Mori with the motivation to provide an electronic commerce system in which information concerning a commodity or service can be provided to a user in a suitable timing (**Mori: col. 2, 44-53**).

24. As per claim 35, the system of claim 34 is as described. White, Kleinberg, and Provost do not explicitly teach wherein the at least one term of the insurance product is the total coverage value of the insurance policy.

Mori teaches wherein the at least one term of the insurance product is the total coverage value of the insurance policy (**Mori: figure 14 & 15**).

The motivation to combine the teachings is the same as claim 34.

25. As per claim 36, the system of claim 35 is as described. White, Kleinberg, and Provost do not explicitly teach wherein the insurance product is travel insurance.

Mori teaches wherein the insurance product is travel insurance (**Mori: figure 14 & 15**).

The motivation to combine the teachings is the same as claim 34.

Response to Arguments

26. Applicant's arguments filed for claims 25-27 have been fully considered but they are not persuasive.

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571) 270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. R. R./
Examiner, Art Unit 3686
July 28, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686